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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/456,249	12/07/1999	DARRYL E. RUBIN	03797.85089	6181

28319 7590 07/08/2004

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EXAMINER

YUAN, ALMARI ROMERO

ART UNIT PAPER NUMBER

2176

DATE MAILED: 07/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/456,249

Applicant(s)

RUBIN ET AL.

Examiner

Almari Yuan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 December 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/09/04, 05/13/04, and 05/26/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: Request for RCE filed 5/07/04, Amendment filed on 3/25/04, Declarations under 37 C.F.R. 1.131 filed on 3/25/04, and IDSs filed 4/09/04, 05/13/04, and 05/26/04.
2. Claims 1-5 are pending in the case. Claims 1, 3, 4, and 5 are independent claims.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/07/04 has been entered.

Information Disclosure Statement

4. The information disclosure statement (IDS) submitted on 4/09/04, 05/13/04, and 05/26/04 has been considered by the Examiner.

Response to Declaration under 37 C.F.R. 1.131, filed 3/25/04

5. The Declaration filed on March 25, 2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the effective published date of Bizweb2000 reference.

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The evidence submitted is insufficient to establish applicant's alleged actual reduction to practice of the invention in this country or a NAFTA or WTO member country after the effective date of the Bizweb2000 reference.

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Bizweb2000 reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

In the declaration, the Applicant does not specifically point out the claimed invention and has not given a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. A general allegation that the invention was completed prior to the date of the reference is not sufficient. Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131.

On page 2 of said declaration, Applicant allegedly declares that the "screenshots" of Exhibit A is evidence for conception and the actual reduction to practice prior to May 8, 1999 and supports claims 1-5 of the present patent application, however, Applicant statements are not sufficient proof or does not show sufficient facts describing the "screenshots" of Exhibit A of how it existed and what they are or when they occurred prior to May 8, 1999 to properly demonstrate the reduction to practice. Applicant is required to show proof and facts that the

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apparatus actually existed and worked for its intended propose for actual reduction to practice. Furthermore, the Applicant has failed to provide a clear explanation of how the claimed invention equates with the "screenshots" of Exhibit A to disclose the conception of the invention as claimed. Referring to the "screenshots" of Exhibit A, screenshot #1 purports to show a "START" page for an e-book; screenshot #2 shows "Table of Contents" page of an e-book, screenshot #3 shows pages from a selected Chapter containing text and a "Notes" window; and screenshot 4 purports to show an "END" page for the e-book, however, none of the "screenshots" appears to describe the conception of the invention as claimed and does not sufficiently describe applicant's claimed invention. Therefore, conception and reduction to practice of the claimed invention has not been established.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Adobe Acrobat 3.0 Reader Online Guide", 9/1996, Adobe Systems, Inc., pages 1-110 (herein after "Adobe") in view of Bizweb2000.com - screenshots of an e-book, published on 5/1999, pages 1-4 (herein after "Bizweb").**

Regarding independent claim 1, Adobe discloses:

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A computer user interface (Adobe on page 2 discloses a user interface) comprising:

a plurality of user interface document pages (Adobe on page 2 and pages 29-30 discloses left display of plurality of linked documents of various topics and a plurality of pages with embedded icons to interact with other pages);

a plurality of user content document pages (Adobe on page 2 discloses plurality of pages with information about of how to use the online guide);

a unified navigational context for allowing a user to interact with both the user interface documents and the user content documents pages (Adobe on page 2 discloses an icon ">" as a directional control for navigation between pages of a document);

at least one of the document pages including at least one link (Adobe on page 2 and page 102 discloses hypertexts links are highlighted in blue to be click by the user and to go to the indicated page or topic); and

at least one of the links linking to command code such that when one of the links linking to command code is activated, the command code linked to the activated link is executed (Adobe on pages 2-3 and page 102 discloses objects and text highlighted in blue are used as links or "Go to" command to another page or topic and on page 35 discloses link to another document is activated).

However, Adobe does not explicitly teach "a unified navigational context for allowing a user to interact with both the user interface documents and the user content documents pages in *a one space model*".

Bizweb on pages 1-4 discloses a multi-page document viewer (see page 2 item C – one space model) comprising directional control buttons to navigate been pages (see page 2 item A –

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user interface page with navigational context), said content pages connected side-by-side (see page 2 item B – user content pages).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Bizweb into Adobe to provide navigational controls in a “one space” view of multiple pages, as taught by Bizweb, incorporated into the online guide of Adobe, in order to better simulate appearance of a physical book (i.e. electronic or e-book style).

Regarding dependent claim 2, Adobe discloses:

further comprising: a Guide Book including a plurality of command descriptions and a plurality of links that are active command instances, the active command instances being invokable in place within the Guide Book (on page 2 and page 102 discloses a description of each object or text (highlighted in blue) to help user use the online guide).

Regarding independent claim 3, Adobe discloses:

A computer user interface for displaying user content documents having links (Adobe on page 2 discloses user interface displaying pages with linking topics and linking objects), the user interface comprising:

a plurality of user interface documents having links (Adobe on page 2 and pages 29-30 discloses left display of plurality of linked documents of various topics and a plurality of pages with embedded icons to interact with other pages); and

a unified navigational context for allowing a user to interact with both the user interface documents and the user content documents by activating the user interface document links and the user content document links (Adobe on page 2 and on pages 29-30 discloses right display of a plurality of pages (user content document) associated with the linking topics on the left display

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(user interface document); on page 2 discloses an icon ">" as a directional control for navigation between pages of a document; on pages 50-52 discloses navigating or paging through a documents; on page 58 discloses tracing your steps with Go Back and Forward buttons).

However, Adobe does not explicitly teach "a unified navigational context for allowing a user to interact with both the user interface documents and the user content documents pages in *a one space model*".

Bizweb on pages 1-4 discloses a multi-page document viewer (see page 2 item C – one space model) comprising directional control buttons to navigate between pages (see page 2 item A – user interface page with navigational context), said content pages connected side-by-side (see page 2 item B – user content pages).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Bizweb into Adobe to provide navigational controls in a "one space" view of multiple pages, as taught by Bizweb, incorporated into the online guide of Adobe, in order to better simulate appearance of a physical book (i.e. electronic or e-book style).

Regarding independent claim 4, Adobe discloses:

A computer user interface (Adobe on page 2 discloses user interface) comprising:

a plurality of user interface document pages (Adobe on page 2 and pages 29-30 discloses left display of plurality of linked documents of various topics and a plurality of pages with embedded icons to interact with other pages);

a plurality of user content document pages (Adobe on page 2 discloses plurality of pages with information about of how to use the online guide);

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a unified navigational context for allowing a user to interact with both the user interface documents and the user content documents pages (Adobe on page 2 discloses an icon ">" as a directional control for navigation between pages of a document);

at least one of the document pages including at least one link (Adobe on page 2 and page 102 discloses hypertexts links are highlighted in blue to be click by the user and to go to the indicated page or topic); and

a selection model for allowing a user to select the object of a command either before or after the user selects the command (Adobe on pages 2-3 and page 102 discloses objects and text highlighted in blue are used as links or "Go to" command to another page or topic).

However, Adobe does not explicitly teach "a unified navigational context for allowing a user to interact with both the user interface documents and the user content documents pages in *a one space model*".

Bizweb on pages 1-4 discloses a multi-page document viewer (see page 2 item C – one space model) comprising directional control buttons to navigate between pages (see page 2 item A – user interface page with navigational context), said content pages connected side-by-side (see page 2 item B – user content pages).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Bizweb into Adobe to provide navigational controls in a "one space" view of multiple pages, as taught by Bizweb, incorporated into the online guide of Adobe, in order to better simulate appearance of a physical book (i.e. electronic or e-book style).

Regarding independent claim 5, Adobe discloses:

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A computer readable medium having computer-executable instructions for performing the step of providing a computer user interface (Adobe on page 2 discloses user interface) wherein

a user accesses user content documents (Adobe on page 2 discloses a left display of plurality of pages accessed by the user clicking on the linking topic on the left display; right display of a plurality of page containing information about the use of an online book (user content),

accesses user interface help information (Adobe page 102: how to use this online guide (help information), and

executes commands by activating links on documents pages and wherein user content documents and user interface documents are presented in a single viewing frame executed (Adobe on pages 2-3 and page 102 discloses objects and text highlighted in blue are used as links or "Go to" command to another page or topic and discloses displaying linking topics left display (user interface document) and linked pages on the right display (user content document) of a single viewing window; on page 35 discloses link to another document is activated).

However, Adobe does not explicitly teach "the user interface documents and the user content documents pages are presented in *a one space model*".

Bizweb on pages 1-4 discloses a multi-page document viewer (see page 2 item C – one space model) comprising directional control buttons to navigate between pages (see page 2 item A – user interface page with navigational context), said content pages connected side-by-side (see page 2 item B – user content pages).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Bizweb into Adobe to provide navigational controls in a

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“one space” view of multiple pages, as taught by Bizweb, incorporated into the online guide of Adobe, in order to better simulate appearance of a physical book (i.e. electronic or e-book style).

Response to Arguments

8. Applicant's arguments filed 3/25/04 have been fully considered but they are not persuasive.

The Examiner's response to Applicant's filing of the Declaration under 37 C.F.R. 1.131 has been addressed in paragraph 5 of the instant Office Action.

Applicant submits no substantial arguments on the merits of the instant rejections as applied Adobe and Bizweb references. Accordingly, no examiner response is deemed necessary.

Conclusion

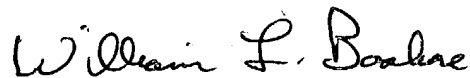
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Almari Yuan whose telephone number is 703-305-5945. The examiner can normally be reached on Mondays - Fridays (8:30am - 5:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild, can be reached on 703-305-9792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AY
July 7, 2004



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